

### **Remarks**

Claims 1-53 are pending in the present application. By this amendment, claims 1, 2, 4, 7, 13, 16, 33, 36, 37, 50 and 52 are amended, and new claim 53 is added. Reconsideration is requested in view of the requested amendments and the following remarks.

Applicants thank the Examiner for indicating that claims 13, 14, 21, 23, 37, 41, and 45 are objected to but would be allowable if re-written in independent form. Claims 13 and 37 have been re-written in independent form incorporating all of the limitations previously recited in these claims and therefore are now allowable.

#### **I. 35 U.S.C. § 112 Rejections of Claim 52**

Claim 52 was rejected under 35 U.S.C. § 112, first paragraph for lack of enablement because the detailed description does not mention the instantly claimed set of instructions. The detailed description has been amended to recite that the eyepieces can be provided with a set of instructions. Thus, this rejection should be withdrawn. The amendment to the specification is supported by the original language of claim 52 in the application as filed.

Claim 52 was also rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. The preamble of claim 52 has been amended to recite “swim goggles assembly.” Applicants believe that the preamble of claim 52 is now consistent with the limitations recited in the body of the claim. Thus, withdrawal of this rejection is requested.

#### **II. Rejection of Claims 7 and 9**

Claims 7 and 9 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,547,802 to Chiang (Chiang). Applicants traverse this rejection and request that it be withdrawn.

Claim 7 has been amended to recite “swim goggles comprising a pair of unconnected eyepieces, each eyepiece adapted to provide a water-tight seal around an eye of a user during use of the goggles, the eyepieces being without any straps extending around the rear of the user’s head and securing the eyepieces to the user’s face in an as worn orientation” (added language underlined). In contrast to claim 7, Chiang discloses a swimming goggles system comprising a first swimming goggle 2, a second swimming goggle 3, and head straps 21, 31 for securing the

goggles 2, 3 to the head of a user. Accordingly, claim 1 is not anticipated by Chiang and is allowable.

Claim 9 depends from claim 7 and is allowable for the reasons given above in support of claim 7 and because claim 9 sets forth an independently patentable combination of features.

### **III. Rejection of Claims 33-36, 40, 42-44, and 46-50**

Claims 33-36, 40, 42-44, and 46-50 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,006,367 to Webster (Webster). Applicants traverse this rejection and request that it be withdrawn.

#### Claims 33-36:

Claim 33 recites an eyepiece for swim goggles comprising a body adapted to be worn over the eye of a user and form a water-tight seal around the eye that isolates the eye from the surrounding environment during use. Claim 33 has been amended to recite that the body comprises a transparent lens portion that includes a first, flat anterior lens that is positioned in front of the eye in an as worn orientation and at least a second, flat lens comprising flat and parallel opposed surfaces, the second lens being connected to the anterior lens at an obtuse angle and extending rearwardly therefrom, wherein the second lens reduces prismatic distortion of the lens portion (added language underlined). Claim 33 also has been amended to incorporate the limitations previously recited in original claim 36 and therefore now recites that the second lens is connected to the anterior lens at an angle of approximately 124° to 164° (added language underlined) (as described on page 18, lines 15-17 of the present application).

Webster discloses swim goggles 10 comprising lens portions 18 and 20. Each lens portion 18, 20 has an anterior lens 50 and an angled, transparent top member 64 that is connected to the superior edge of the lens 50 and extends rearwardly and superiorly from the lens 50. The object of the Webster “invention” is to permit a swimmer to see horizontally an object in front of the swimmer while swimming with the head facing downwardly. This object is accomplished by positioning the top member 64 at an angle A (FIGS. 5 and 6) that maximizes the refraction of light rays passing through the top member 64. Col. 2, lines 34-37 and col. 4, line 55 through col. 5, line 3.

In one embodiment of Webster’s goggles, the top member 64 comprises a flat plate oriented at an angle A (FIG. 5) with respect to a plane extending from the anterior lens 50. The

angle A in this embodiment ranges from a minimum of 70 degrees and 90 degrees. Col. 4, lines 21-26. The actual angle defined between the top member 64 and the anterior lens 50 therefore ranges between 90 degrees and a maximum of 110 degrees (180 degrees - 70 degrees). Since the angle between the top member 64 and the anterior lens 50 can be no greater than 110 degrees, Webster's goggles do not satisfy the limitations of claim 33, which recites that the second lens is connected to the anterior lens at an angle of approximately 124 degrees to 164 degrees.

Applicants note that FIGS. 3, 6 and 7 of Webster show another embodiment in which the top member 64 comprises a prism 90. The prism comprises a top surface 92 that extends at an angle Z relative to a bottom surface 94 (FIG. 6). In contrast, claim 33, as amended, specifies that the opposed surfaces of the second lens are flat and parallel. Thus, this embodiment of Webster does not satisfy the combination of features recited in claim 33.

Accordingly, for at least the foregoing reasons, claim 33 is not anticipated or rendered obvious by Webster and is allowable.

Claims 34-36 depend from claim 33 and are allowable for the reasons given above in support of claim 33 and because each dependent claim sets forth an independently patentable combination of features.

Claim 34, for example, further recites that the second lens is a side lens that extends rearwardly and temporally from the anterior lens. Webster's top member 64 is not the same as the side lens recited in claim 34 because the top member clearly extends superiorly (i.e., upwardly towards the brow) from the anterior lens 50, not temporally (towards the temple) as recited in claim 34. As discussed above, the top member 64 is specifically positioned to extend in the superior direction relative to the lens 50 to allow a swimmer to see an object horizontally in front of the swimmer while swimming with the head facing downwardly in the water. There is no indication in Webster regarding the need or desirability of utilizing an angled side lens that extends temporally from the anterior lens 50.

Claim 35, which depends from claim 34, further recites that the side lens is connected to the anterior lens at an angle at which a line of sight extends perpendicularly with respect to the side lens whenever the eye is rotated temporally to a position at which the visual axis intersects a midpoint of the side lens. As discussed above, there is teaching or suggestion in Webster for an angled side lens. Thus, there certainly is no teaching or suggestion for the limitation recited in claim 35. Moreover, in the rejection of claim 35, the Office action fails to provide any support

for Webster disclosing or suggesting the limitation recited in this claim. Applicants request clarification of the relevance of Webster with respect to the claim 35 if this rejection is not withdrawn.

Claims 40, 42-44, 46, and 47:

Claim 40 recites swim goggles comprising a pair of eyepieces, each eyepiece being shaped to provide a water-tight seal around an eye of a user during use of the goggles. Claim 40 also recites that each eyepiece has a flat, transparent anterior lens that is positioned in front of a respective eye in an as worn orientation and a flat, transparent side lens connected to and inclined away from a respective anterior lens in a temporal direction so as to reduce hydrodynamic drag and prismatic distortion of the respective eyepiece.

In the rejection of claim 40, the Examiner contends that the top surface 66 of top member 64 in Webster's goggles is a side lens that extends in a temporal direction. Applicants disagree. Unlike claim 40, the top member 64 in Webster's goggles clearly extends in the superior direction (i.e., upwardly towards the brow) from the anterior lens 50, not in the temporal direction (towards the temple). Furthermore, Webster teaches away from the construction recited in claim 40 because if the top member 64 is configured to extend in the temporal direction rather in the superior direction, a user would not be able to see horizontally objects in front of him while swimming with the head facing downwardly in the water.

Claims 42-44, 46, and 47 depend from claim 40 and are allowable for the reasons given above in support of claim 33 and because each dependent claim sets forth an independently patentable combination of features. For example, claim 42 recites that the side lens is oriented with respect to the anterior lens such that a line of sight along the visual axis intersects the side lens at 90 degrees whenever the eye is rotated to a temporal position at which the visual axis intersects the side lines. Claim 43, which depends from claim 42, further recites that the line of sight extends through a midpoint of the side lens. The Office action fails to provide any support for Webster disclosing or suggesting the limitations recited in claims 42 or 43. Applicants request clarification of the relevance of Webster with respect to these claims if this rejection is not withdrawn.

Claims 48 and 49:

Claim 48 recites swim goggles comprising two frame portions, two, flat anterior lenses coupled to respective frame portions, and two, flat side lenses, each connected to a respective

anterior lens and extending rearwardly and temporally therefrom, each side lens being oriented with respect to an anterior lens such that there is no prismatic distortion of an image viewed along a line of sight intersecting the side lens.

In contrast to claim 48, and as show in FIGS. 1 and 3-7 of Webster, the top surface 66 of top member 64 clearly extends in the superior direction (i.e., upwardly towards the brow) from the anterior lens 50, not in the temporal direction (towards the temple). Furthermore, Webster teaches away from the construction recited in claim 48 because if the top member 64 extended in the temporal direction rather in the superior direction, a user would not be able to see horizontally objects in front of him while swimming with the head facing downwardly in the water.

Claim 49 depends from claim 48 and is allowable for the reasons given above in support of claim 48 and because claim 49 sets forth an independently patentable combination of features.

Claim 50:

Claim 50 recites an eyepiece for swim goggles comprising a body adapted to be worn over the eye of a user, wherein the body comprises a transparent lens portion. Claim 50 has been amended to recite that lens portion includes a first, anterior lens and a second side lens that is connected to the anterior lens at an obtuse angle and extends rearwardly and temporally therefrom so as to reduce prismatic distortion of the lens portion (added language underlined). Unlike claim 50, in Webster, the top surface 66 of top member 64 extends in the superior direction (i.e., upwardly towards the brow) from the anterior lens 50, not in the temporal direction (towards the temple).

**IV. Rejection of Claims 1-5**

Claims 1-5 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious from U.S. Patent No. 5,331,691 to Runckel (Runckel) in view of U.S. Patent No. 6,609,255 to Lane (Lane). Applicants traverse this rejection and request that it be withdrawn.

Claim 1 has been amended to incorporate the limitations previously recited in original claim 2. Claim 1 now recites an eyepiece for swim goggles comprising a protective body adapted to be worn over an eye of a user, the body comprising a transparent lens portion and a frame portion surrounding the lens portion wherein the frame portion is shaped to generally conform to the shape of the orbital rim. Claim 1 also includes an adhesive layer that adhesively

secures the body to the skin of the user in close proximity to the eye so as to form a substantially water-tight seal around the eye that substantially isolates the eye from the surrounding environment during use.

The Office action concedes that Runckel does not disclose adhesive tape for securing and eyepiece to the skin of a user. However, the action contends “it would have been obvious . . . to modify Runckel’s apparatus by replacing the strap . . . with an adhesive layer that would serve the function of attaching the body to the face and subsequently creating a water-tight seal as an alternative means as taught by Lane.” In reply, Applicants submit that this contention does not support any combination of Runckel and Lane to derive the subject matter recited in claim 1.

As best shown in FIG. 4, Runckel discloses swim goggles comprising a left eyepiece 12 and a right eyepiece 12a. Each eyepiece 12, 12a has a respective strap support flange 25, 25a for securing a head strap 24 (FIG. 1). As shown in FIG. 4, the support flanges 25, 25a extend upwardly from the eyepieces 12, 12a to orient the strap in an upwardly pulling position so that each eyepiece is urged up against the inner side of the supra-orbital border creating a more comfortable and efficient goggle design. Col. 3, lines 13-19 and col. 5, lines 16-21.

There is no suggestion to combine or modify a prior art reference if the reference teaches away from making the specific combination of elements recited in a claim. *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360, 52 U.S.P.Q. 2d 1294, 1298 (Fed. Cir. 1999). Applicants submit that Runckel teaches away from a strapless design because a user could not achieve the desired positioning for Runckel’s eyepiece without the use of a head strap. Thus, a skilled person would not have been motivated to replace Runckel’s head strap 24 with an alternative means for securing the eyepieces to the face of a user.

Moreover, there is no teaching or suggestion in Lane that adhesive tape can be used to secure swim goggles to the skin of a user. Lane concerns an eyeshield 10 that is used to protect the eye of a patient, for example, following eye surgery. The eyeshield 10 includes a plurality of vents 14 to expose a user’s eye to fresh air and therefore could not be used to keep water from contacting the eye in an underwater environment. Although Lane indicates that tape can be used instead of a strap to affix the eyepiece 10 to a user’s face, there is no teaching or suggestion in Lane that tape is a suitable alternative to a head strap for securing swim goggles to the head of a user and creating a water-tight seal around the user’s eye. Because Lane’s eyepiece 10 would not (and could not) be used in an underwater environment, Lane inherently does not address

creating a water-tight seal around the user's eyes or explain how swim goggles can be adapted to be secured to the head of a user with an adhesive layer rather than a conventional head strap. Thus, a skilled person would have no motivation from Lane to modify Runckel's swim goggles in the manner suggested by the Examiner.

Accordingly, for the foregoing reasons, claim 1 is not rendered obvious by Runckel in view of Lane and is allowable.

Claims 2-5 depend from claim 1 and are allowable for the reasons given above in support of claim 1 and because each dependent claim sets forth an independently patentable combination of features.

For example, claim 2 has been amended to recite that the frame has a posterior surface and the adhesive layer comprises double-sided tape having a first adhesive surface adhesively secured to the posterior surface of the frame and a second adhesive surface that adhesively secures the frame to the skin. In contrast, conventional adhesive tape, such as might be used by a patient to secure Lane's eyepiece 10 to the skin, has only one adhesive surface. Although not described in Lane, such tape can be used to secure the eyepiece by applying a piece of tape such that a portion adheres to the anterior (front) surface of the eyepiece 10 and another portion extends over and adheres to the adjacent skin. However, if the piece of tape is applied to the posterior surface of the eyepiece, the non-adhesive side would seat against the skin. Thus, conventional adhesive tape, as understood to be disclosed in the Lane, cannot be used to secure an eyepiece to the skin in the manner recited in claim 2.

## **V. Rejection of Claim 6**

Claim 6 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Runckel in view of Lane and U.S. Patent No. 5,940,892 to Morgan (Morgan). Applicants traverse this rejection and request that it be withdrawn.

Claim 6 depends from claim 1 and is allowable for the reasons given above in support of claim 1 and because claim 6 further recites a cover layer overlaying the adhesive layer and adapted to be removed from the adhesive layer prior to use.

## **VI. Rejection of Claims 8, 15, 16, 20, 22, and 24**

Claims 8, 15, 16, 20, 22, and 24 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Chiang in view of Lane. Applicants traverse this rejection and request that it be withdrawn.

### Claims 8, 15, and 16:

Claims 8, 15, and 16 depend from claim 7 and are allowable for the reasons given above in support of claim 7 and because each dependent claim sets forth an independently patentable combination of features.

Claim 8 further recites that each eyepiece includes a body and an adhesive for adhering the body to the user's skin adjacent a respective eye. In the rejection of claim 8, the action contends that "it would have been obvious . . . to modify Chiang's apparatus by replacing the strap . . . with an adhesive layer as an alternative means of attaching the body to the skin of the user and subsequently creating a water-tight seal as taught by Lane." Applicants submit that this contention does not support any combination of Chiang and Lane to derive the subject matter recited in claim 8.

Chiang, for instance, discloses a swimming goggles system comprising a first swimming goggle 2, a second swimming goggle 3, and head straps 21, 31 for securing the goggles 2, 3 to the head of a user. An object of the Chiang "invention" is to provide separate head straps 21, 31 for each goggle to ensure that each goggle can seal the periphery of the eye sockets and prevent the seepage of water. Col. 1, lines 52-67. Another object of the Chiang "invention" is to provide a thread connection element 25 for connecting the head straps 21, 31 of the goggles 2, 3. Col. 2, lines 7-11. Chiang teaches against the proposed modification because removing the straps 21, 31 from Chiang's goggles would run directly counter to Chiang's requirement of using straps to prevent the seepage of water and because the thread connection element 25 could not be used to link together the goggles 2, 3 if the straps are removed.

Furthermore, there is no teaching or suggestion in Lane that tape is a suitable alternative to Chiang's head straps for securing swim goggles to the head of a user and creating a water-tight seal around the user's eye. Because Lane's eyepiece 10 would not (and could not) be used in an underwater environment, Lane inherently does not address creating a water-tight seal around the user's eyes or explain how swim goggles can be adapted to be secured to the head of



a user with an adhesive layer rather than a conventional head strap. Thus, a skilled person would have no motivation from Lane to modify the swim goggles shown in Chiang in the manner suggested by the Examiner.

Claim 15 recites that each eyepiece has a layer of adhesive tape for adhesively securing the eyepiece to the skin. As discussed above, neither Chiang nor Lane teaches or suggests swim goggles having adhesive tape for securing the goggles to the skin of a user.

Claim 16, as amended, further recites that each adhesive tape comprises a deformable layer that is secured to the posterior surface of a frame and has an adhesive surface for adhering to the skin. In the rejection of claim 16, the action contends that Lane discloses that the tape comprises a deformable layer having an adhesive surface for adhering to the skin. Applicants submit that there is no such disclosure in Lane regarding a deformable layer having an adhesive surface. The action cites col. 3, lines 39-42 of Lane as disclosing this feature. This passage of Lane describes using “adhesive tape” or another adhesive for affixing the eyepiece to a user’s face. There is no hint or suggestion in Lane regarding the need or desirability of using a deformable adhesive tape for securing the eyepiece to the user’s face.

Furthermore, conventional adhesive tape, such as might be used by a patient to secure Lane’s eyepiece 10 to the skin, has only one adhesive surface. Although not described in Lane, such tape can be used to secure the eyepiece by applying a piece of tape such that a portion adheres to the anterior (front) surface of the eyepiece 10 and another portion extends over and adheres to the adjacent skin. However, if the piece of tape is applied to the posterior surface of the eyepiece, the non-adhesive side would seat against the skin. Thus, conventional adhesive tape, as understood to be disclosed in the Lane, cannot be used to secure an eyepiece to the skin in the manner recited in claim 16.

Claims 20, 22, and 24:

Claim 20 is directed to a method of using strapless swim goggles comprising a pair of unconnected eyepieces. The method comprises securing the eyepieces to a user’s face adjacent the eyes without the aid of a strap extending around the user’s head. Neither Chiang nor Lane (either alone or in combination) teaches or suggests the method recited in claim 20.

In the rejection of claim 20, the action contends that “it would have been obvious . . . to modify Chiang’s method to secure the eyepieces to the skin by using an adhering means rather than straps as taught by Lane et al. since adhering the eyepieces to the skin performs the same

function as the straps.” Applicants disagree with this contention. The Lane device is used for an entirely different purpose and under much different conditions than Chiang’s swim goggles. Neither Lane nor Chiang recognizes that tape can be used as a suitable alternative to head straps for adequately securing swim goggles to the face of a swimmer during use or that tape can be used to create a water-tight seal between the eyepiece and the user’s face. Furthermore, Chiang teaches against the proposed modification because removing the straps 21, 31 from Chiang’s goggles would run directly counter to Chiang’s express requirement of using straps to prevent the seepage of water and because the thread connection element 25 could not be used to link together the goggles 2, 3 if the straps are removed.

Claims 22 and 24 depend from claim 20 and are allowable for the reasons given above in support of claim 20 and because each dependent claim sets forth an independently patentable combination of features.

## **VII. Rejection of Claim 25**

Claim 25 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Chiang in view of Lane and Runckel. Applicants traverse this rejection and request that it be withdrawn.

Claim 25 depends from claim 20 and is allowable for the reasons given above in support of claim 20 and because claim 25 further recites positioning at least a portion of each eyepiece within an orbital rim. In the rejection of claim 25, the action contends that it would have been obvious to modify the combination of Chiang and Lane “by positioning at least a portion of each eyepiece within an orbital rim as taught by Runckel.” Applicants disagree.

Under MPEP § 2145 (X)(D)(2), it is improper to combine references where the references teach away from their combination. As discussed above, Runckel employs support flanges 25, 25a that extend upwardly from the eyepieces 12, 12a to orient the strap in an upwardly pulling position so that each eyepiece is urged up against the inner side of the supra-orbital border. Col. 3, lines 13-19 and col. 5, lines 16-21. Runckel teaches away from the proposed combination because it would be impossible to achieve the desired positioning for the eyepieces, as taught by Runckel, without the use of a head strap. Thus, it would not have been obvious to combine the references to derive claimed combination of features.

### **VIII. Rejection of Claims 10-12 and 17**

Claims 10-12 and 17 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Chiang in view of Runckel. Applicants traverse this rejection and request that it be withdrawn.

Claims 10-12 and 17 depend from claim 7 and are allowable for the reasons given above in support of claim 7 and because each dependent claim sets forth an independently patentable combination of features.

Claim 10, for example, recites that each peripheral flange is sized and shaped to fit at least partially within a respective orbital rim. In the rejection of claim 10, the action contends that it would have been obvious to modify Chiang's goggles "to require the peripheral flanges to be sized and shaped to fit at least partially within the respective orbital rims . . . as taught by Runckel." Applicants disagree with this contention. Unlike Chiang and Lane, Runckel employs support flanges 25, 25a that extend upwardly from the eyepieces 12, 12a to orient the strap in an upwardly pulling position so that each eyepiece is urged up against the inner side of the supra-orbital border. Runckel teaches away from the proposed combination because it would be impossible to achieve the desired positioning for the eyepieces, as taught by Runckel, without the use of a head strap.

### **IX. Rejection of Claim 32**

Claim 32 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Chiang in view of Runckel, Lane, and Morgan. Applicants traverse this rejection and request that it be withdrawn.

Claim 32 recites swim goggles comprising a pair of unconnected eyepieces, wherein each eyepiece comprises a transparent lens portion and a frame portion surrounding the lens portion. Claim 32 also requires a layer of adhesive tape secured to frame portion of each eyepiece and having an adhesive surface for adhering to the skin adjacent the eye and a removable cover layer overlaying the adhesive surface of each layer of adhesive tape. Neither Chiang, Runckel, Lane, nor Morgan teaches or suggests the combination of features recited in claim 32.

In the rejection of claim 32, the action contends that "it would have been obvious . . . to modify the combination of Chiang and Runckel by replacing the strap . . . with an adhesive layer

as an alternative means of attaching the body to the skin of the user and subsequently creating a water-tight seal as taught by Lane.” Applicants disagree with this contention. As discussed above, the Lane device is used for an entirely different purpose and under much different conditions than Chiang’s swim goggles. Neither Lane, Runckel, nor Chiang recognizes that tape can be used as a suitable alternative to head straps for adequately securing swim goggles to the face of a swimmer during use or that tape can be used to create a water-tight seal between the eyepiece and the user’s face. Furthermore, Chiang teaches against the proposed modification because removing the straps 21, 31 from Chiang’s goggles would run directly counter to Chiang’s express requirement of using straps to prevent the seepage of water and because the thread connection element 25 could not be used to link together the goggles 2, 3 if the straps are removed.

The action also contends that it would have been obvious to modify Chiang’s goggles “to configure the frame portions to at least fit partially within an orbital rim as taught by Runckel.” Applicants disagree with this contention. Unlike Chiang and Lane, Runckel employs support flanges 25, 25a that extend upwardly from the eyepieces 12, 12a to orient the strap in an upwardly pulling position so that each eyepiece is urged up against the inner side of the supra-orbital border. Runckel teaches away from the proposed combination because it would be impossible to achieve the desired positioning for the eyepieces, as taught by Runckel, without the use of a head strap.

For at least the foregoing reasons, claim 32 is not rendered obvious by Chiang in view of Runckel, Lane and Morgan and is allowable.

#### **X. Rejection of Claim 18 and 19**

Claims 18 and 19 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Chiang in view of Webster. Applicants traverse this rejection and request that it be withdrawn.

Claims 18 and 19 depend from claim 7 and are allowable for the reasons given above in support of claim 7 and because each dependent claim sets forth an independently patentable combination of features.

Claim 18, for example, further recites that each eyepiece comprises a flat anterior lens portion that is positioned in front of an eye in an as worn orientation and a flat side lens portion

that extends rearwardly and temporally from a respective anterior lens portion at an obtuse angle. Unlike claim 18, the top member 64 in Webster's goggles clearly extends in the superior direction (i.e., upwardly towards the brow) from the anterior lens 50, not in the temporal direction (towards the temple). As recognized by the Examiner, the top member 64 allows a swimmer to see horizontally an object in front of the swimmer while swimming with the head facing downwardly in the water. Webster teaches away from the construction recited in claim 18 because if the top member 64 is configured to extend in the temporal direction rather in the superior direction, a user would not be able to see horizontally objects in front of him while swimming with the head facing downwardly in the water.

#### **XI. Rejection of Claims 26-29**

Claims 26-29 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Webster in view of Lane. Applicants traverse this rejection and request that it be withdrawn.

Claim 26 recites an eyepiece for swim goggles comprising a body that comprises a transparent lens and a peripheral flange surrounding the lens, wherein the flange has a posterior surface, and an adhesive layer mounted on the posterior surface of the flange. Neither Webster nor Lane (either alone or in combination) teaches or suggests the instantly claimed swim goggles.

In the rejection of claim 26, the action contends that Lane "discloses an adhesive layer mounted on the posterior surface of the flange [of the eyepiece 10]." Lane provides no such disclosure. At most, Lane describes using adhesive tape or another adhesive for affixing the eyepiece 10 to the user's face. See col. 3, lines 39-42 of Lane. However, nowhere in Lane is there any disclosure for providing an adhesive layer on the posterior surface of the eyepiece.

The action further contends that "it would have been obvious . . . to modify Webster's apparatus by replacing the strap . . . with an adhesive layer that would serve the function of attaching the body to the face and subsequently creating a water-tight seal as an alternative means as taught by Lane." Applicants disagree with this contention. The Lane device is used for an entirely different purpose and under much different conditions than Webster's swim goggles, and there is no indication in the prior art that the teachings of Lane could be applied to swim goggles. Contrary to the Examiner's contention, neither Lane nor Webster recognizes that tape can be used as a suitable alternative to head straps for adequately securing swim goggles to

the face of a swimmer during use or that tape can be used to create a water-tight seal between swim goggles and the user's face.

For the foregoing reasons, claim 26 is not obvious from Webster in view of Lane and is allowable.

## **XII. Rejection of Claim 38**

Claim 38 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Webster in view of Runckel. Applicants traverse this rejection and request that it be withdrawn.

Claim 38 depends from claim 33 and is allowable for the reasons given above in support of claim 33 and because claim 38 sets forth an independently patentable combination of features.

## **XIII. Rejection of Claim 39**

Claim 39 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Webster in view of Runckel and Lane. Applicants traverse this rejection and request that it be withdrawn.

Claim 39 depends from claim 33 and is allowable for the reasons given above in support of claim 33 and because claim 39 sets forth an independently patentable combination of features.

## **XIV. Rejection of Claim 51**

The action indicates that claim 38 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Webster in view of U.S. Patent No. 3,944,345 to Decorato (Decorato). Applicants assume that this was a typographical error and that claim 51, not claim 38, was rejected as being obvious from Webster in view of Decorato. In any case, Applicants traverse this rejection and request that it be withdrawn.

Claim 51 depends from claim 50 and is allowable for at least the reasons discussed above in support of claim 50 and because claim 51 sets forth an independently patentable combination of features.

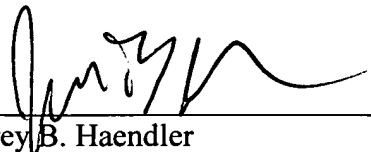
**XV. Conclusion**

The present application is in condition for allowance and such action is respectfully requested. If any further issues remain concerning this application, the Examiner is invited to call the undersigned to discuss such matters.

Respectfully submitted,

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